REMARKS

Claims 1, 3 – 55, and 72 – 82 are pending in this application. The Description of Claims, Item 4, on page 1 of the Office Action incorrectly shows claims 1, 3 – 54, and 70 – 82 are pending in the application. A Declaration of Larry D. McMillan is enclosed.

The Examiner has rejected claims 72 – 81 under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Claims 72 – 81 have been amended to overcome this rejection.

The Examiner has rejected claims 1, 3 – 15, 17 – 34, 36 – 54, and 70 – 81 under 35 USC 103(a) as being unpatentable over Hsu et al. (US Patent No. 6,506,643). Since claims 70 and 72 were canceled in the previous amendment and response filed 07/20/2005, it is presumed that the Examiner is rejecting claims 1, 3 – 15, 17 – 34, 36 – 54, and 72 – 81. Claim 1 has been amended to include the limitation of claim 7, and claims 6 and 7 have been canceled. Insofar as the above rejection applies to claim 7, it is traversed for the reasons given below. Claim 72 has been amended to overcome the rejection as indicated below. All the other claims depend on either claim 1 or claim 72 and are patentable at least because they depend on a patentable claim.

The Office Action rejected claim 1 and former claim 6 on the grounds that it would have been obvious for one of ordinary skill in the art to modify Hsu et al. to arrive at the presently claimed thicknesses. However, this is not correct, since it was not possible for one of ordinary skill in the art to obtain the claimed thicknesses prior to the disclosure of the present application. See the McMillan Declaration, ¶¶6 – 20.

The Office Action also rejected claim 1 and former claim 6 on the grounds that the only difference between the prior art and the claims was the recitation of relative dimensions that would not cause the claimed device to perform differently than the prior art device, citing *Gardner v. TEC Systems Inc.*, 220 USPQ 777 (Fed. Cir. 1984). This rejection is in error for several reasons. First, the Examiner herself admits that the claimed device would perform differently, and cites this for motivation for making the claimed device, i.e., it would result in storing more memory in less space. In contrast, the *Gardner* Court found that the dimensions recited in the claims in that case amounted to no more than "window dressing"; that is, they made no difference at all in performance. See *Gardner*, p. 784. Secondly, in this case, it was not possible to make a device with the claimed

dimensions prior to the present disclosure, which was not true in *Gardner*. Thus, the rule of *Gardner* cannot apply to the present fact situation.

Claim 72 has been amended to include structure not shown in Hsu et al.; namely, the capacitor is formed on a conducting plug passing through the interlayer dielectric and having a height that is greater than the height of the transistor. Not only is this not shown in Hsu et al., it is taught against in Hsu et al. See column 1, lines 54 – 59. In fact, however, the claimed structure has the advantage that it allows the processes that make a better capacitor to not affect the transistor. See the McMillan Declaration, ¶14. Thus, claim 72 is patentable over Hsu et al.

The Examiner has objected to claims 16, 35, and 55 as being dependent upon a rejected base claim. This objection is respectfully traversed on the grounds that the base claims have been amended to be patentable.

Applicants thank the Examiner for the allowance of claim 82.

In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance. Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-1848, under Order No. 013176.0431C1US from which the undersigned is authorized to draw.

Respectfully submitted,
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Dated: 12/30/05

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